REMARKS

By this amendment, non-elected claims 1-31 have been cancelled, claims 32 and 34 have been amended, and new claim 35 has been added. A Request for Approval of Drawing Changes has been filed to amend Fig. 2 by removing a duplicate reference numeral 38 and several miscellaneous stray marks included in the original drawing. No new matter has been added by these amendments.

In the Office Action, the Examiner maintained the original restriction requirement of Groups I-V, all drawn to dispensers, and made it final. Although Applicant does not necessarily agree with the requirement, Applicant has cancelled non-elected claims 1-31. Applicant reserves the right to challenge any restriction applied to those claims if Applicant files a divisional application including claims 1-31.

Claims 32 and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,924,617 to LaCount et al.

Claim 32, as amended, is directed to a method of dispensing that includes, among other aspects, moving at least one raised portion of a second rotatable roller into at least one recessed portion of a first rotatable roller. LaCount et al. fails to disclose such a method of dispensing.

In the Office Action, the Examiner asserted that LaCount et al. discloses "a first rotatable roller (120) having at least one recessed portion (between segments 121) and a second roller (105) having at least one raised portion (110)." Applicant submits that the Section 102 rejection should be withdrawn because LaCount et al. lacks any disclosure of moving one or more raised portions of one roller into one or more recessed portions of another roller, as now recited in claim 32.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Claim 34 has been amended to place it in independent form. That claim was rejected under 35 U.S.C. § 103(a) as being unpatentable over LaCount et al. in view of U.S. Patent 119, 235 to McDonald.

Applicant respectfully disagrees with the § 103(a) rejection. To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine references. Second, there must be a reasonable expectation of success. Third, the references must teach or suggest all the claim elements. *See* M.P.E.P. § 2143. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See* M.P.E.P. § 706.02(j).

In making the § 103(a) rejection, the Examiner asserted that "McDonald teaches the use of a slot through a roller to securely retain sheet material." Applicant respectfully disagrees with the Examiner's assertion about the teaching of McDonald and the attempt to combine that reference with LaCount et al.

McDonald discloses an improvement in spindles for a clothes-wringer roll. There is nothing to support the Examiner's assertion that McDonald discloses a slot through a roller to securely retain sheet material. McDonald mentions attaching rubber to the outer surface of the spindle (column 2, lines 4-19) (e.g., a rubber sleeve that would cover any slot) and using the resulting structure to form a clothes-wringer roll, so there would not be any sheet material retained by a slot defined by that spindle. Furthermore, there is no reason why one of ordinary skill in the art would look to McDonald's

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

disclosure relating to a spindle for a clothes-wringer roll in order to modify the towel dispenser disclosed in LaCount et al. Clothes wringing and towel dispensing are completely non-analogous arts.

Moreover, the Examiner's statements of motivation are merely conclusory. Analogous to a recent Federal Circuit decision,

> "[t]he examiner's conclusory statements . . . do not adequately address the issue of motivation . . . . This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been led to [modify a reference] simply to "[use] that which the inventor taught against its teacher."

In re Lee, No. 00-1158, slip op. at 6 (Fed. Cir. Jan. 18, 2002) (citation omitted).

In the absence of any suggestion or motivation in the references themselves, and in the absence of any sufficient explanation supporting the alleged motivation, it appears that the Examiner has relied instead on hindsight and the teaching of the Applicant's own disclosure to reject claim 34. Because the Office Action does not establish a *prima facie* case of obviousness, this rejection should be withdrawn.

Claims 33 and 35 depend from claim 32 and are allowable for at least the same reasons that claim 32 is allowable.

Applicant respectfully requests that the Examiner reconsider the application, withdraw all of the claim rejections, and issue a Notice of Allowability in a timely manner.

Applicant notes that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether such assertions are addressed above, Applicant declines to necessarily subscribe to any assertion in the Office Action.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

If a telephone conversation might expedite prosecution, the Examiner is invited to call the undersigned (571-203-2700).

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: May 14, 2003

By: Chad D. Wells
Chad D. Wells
Reg. No. 50,875

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com